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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,958	06/27/2001	John Ricciardi	101831-000200-NP	3824
24964	7590	07/27/2004	EXAMINER	
GOODWIN PROCTER L.L.P 103 EISENHOWER PARKWAY ROSELAND, NJ 07068			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/892,958	<b>Applicant(s)</b> RICCIARDI, JOHN	
	<b>Examiner</b> Nga B. Nguyen	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This Office Action is the answer to the communication filed on June 27, 2001, which paper has been placed of record in the file.
2. Claims 1-3 are pending in this application.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

Claims 1-2 merely manipulate an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

As to claims 1-2, the invention is not implemented on a specific apparatus; therefore, the invention is not directed to the technological arts. To be statutory, the utility of an invention must be within the technological arts. The definition of

"technology" is the "application of science and engineering to the development of machines and procedures in order to enhance or improve human conditions, or at least to improve human efficiency in some respect." (Computer Dictionary 384 (Microsoft Press, 2d ed. 1994)). When one looks to the present specification to determine what the applicant has invented, the invention appears to be a series of steps performed on a computer. It is clear that claims 1-2 are intended to be directed to the abstract method apart from the apparatus for performing the method. Therefore, claims 1-2 are non-statutory, because they are directed solely to an abstract idea without practical application in the technological arts.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson, U.S. Patent No. 6,484,152.

Regarding to claim 1, Robinson discloses a method for identifying and selecting an investment item comprising the steps of:

receiving a plurality of investment items (column 5, lines 45-53; the user selects the number of stocks included in the portfolio);

causing a strategy to be selected to apply to such plurality of investment items (column 5, line 60-column 6, line 50; constructing an  $n \times m$  matrix with  $n$  characteristic and investment limits across the top, and the  $m$  candidate stocks down the site);

causing a time-scale to be selected for use by the strategy (column 6, lines 6-7; generating performance for nest twelve months);

applying the strategy to the plurality of investment items over the time-scale (column 7, line 10-column 8, line 32; establishing objective function in optimizing portfolio);

generating an investment signal for each investment item as a result of applying the strategy to at least one investment item (column 8, lines 25-32; outputting the set of individual stocks and the number of shares, yields the grates valuation possible from the universe of candidate stocks);

transmitting the investment signal to a display device (column 9, lines 45-65 and figures 3J-3M).

Regarding to claim 2, Robinson discloses a method for identifying and selecting an investment item comprising the steps of:

receiving a plurality of investment items (column 5, lines 45-53; the user selects the number of stocks included in the portfolio);

causing a plurality of strategies to be selected to apply to such plurality of investment items (column 5, line 60-column 6, line 50; constructing an  $n \times m$  matrix with  $n$

characteristic and investment limits across the top, and the m candidate stocks down the site);

causing a time-scale associated with each strategy to be selected for use by the strategy (column 6, lines 6-7; generating performance for next twelve months);

applying each strategy to the plurality of investment items over the associated time-scale (column 7, line 10-column 8, line 32; establishing objective function in optimizing portfolio);

generating an investment signal for each investment item for each strategy as a result of applying each strategy to at least one investment item (column 8, lines 25-32; outputting the set of individual stocks and the number of shares, yields the grades valuation possible from the universe of candidate stocks);

applying a weight to each investment signal for an investment item (column 9, lines 10-40 and figure 3K);

generating an aggregated investment signal by aggregating all weighted investment signals for an investment item (column 7, lines 18-65);

transmitting the aggregated investment signal to a display device (column 9, lines 45-65 and figures 3J-3M).

Regarding to claim 3, Robinson discloses system for identifying and selecting an investment item comprises: a receiver, a transmitter, a processor (figure 1 and column 2, lines 40-67; the APS computer system 102 comprises input, output, control devices and the CPU 104) for performing the series of steps as described in claim 1 above.

**Conclusion**

7. Claims 1-3 are rejected.
8. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Rebane (US 6,078,904) discloses a computer system and method for optimally allocating investment funds of an investor in a portfolio having a plurality of investments.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
C/o Technology Center 3600  
Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

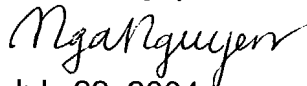
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(703) 308-3691 (for informal or draft communication, please label  
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen



July 22, 2004